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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,920	09/30/2003	Christopher P. Knapp	279.640US1	2079

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER

SMITH, TERRI L

ART UNIT	PAPER NUMBER
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3762

MAIL DATE	DELIVERY MODE
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01/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/675,920

Applicant(s)

KNAPP ET AL.

Examiner

Terri L. Smith

Art Unit

3762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED on 13 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-45.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

GEORGE R. EVANISKO
PRIMARY EXAMINER

12/26/06

23 December 2003

Continuation of 3. NOTE: : The addition of the phrases "and not adjacent to the surface of the electrode" (claim 1) and "the second layer comprises a matrix including a polymer and at least one pharmacological agent and" (claims 11 and 40) and "matrix" (claims 11 and 40) and "first layer of the" (claim 35) and the deletion of "second layer" (claims 11 and 35) raises new issues which require further search and consideration. .

Continuation of 11. does NOT place the application in condition for allowance because: The arguments regarding claims 1 and 35 and their dependent claims are related to the new issues which will require further search and consideration. All of Applicant's remaining arguments have been considered, but they are not persuasive.

Examiner respectfully disagrees with Applicant's argument regarding claim 16 that "In contrast, Vachon does not show or discuss that material 72 is over sheath 38 at any portion of the sheath." In column 3, line 62 -column 4, line 2, Vachon et al. teaches "Proceeding toward the distal end of the conductive electrode 50, the conductive electrode 50 includes a neck area 58 having a reduced diameter from the cylinder 52 which provides a recessed area into which an interior extending ridge of the tine sheath 38 is inserted to provide positive engagement of the tine sheath 38 with the conductive electrode 50. Finally, the conductive electrode 50 terminates at an electrode distal tip 60. And, in column 4, lines 42-43, Vachon et al. teaches "The coating material 72 is applied to the electrode distal tip 60 to thoroughly coat the distal tip 60. It is apparent that the engaged portion of the tine sheath 38 at the neck area 58 with the conductive electrode 50 that terminates at the electrode distal tip 60 which is thoroughly coated with coating material 72 is covered by the coating material at the junction where they touch because the coating material is on top of the tine sheath as described, shown and interpreted by the Examiner in the Office Action mailed on 13 October 2006, and as restated by the Applicant.

Regarding Applicant's arguments against claims 30, 33 and 34, Examiner respectfully disagrees. In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Stokes and Sirhan et al. references are in the same field of endeavor, specifically, an implantable device that elutes drugs, and therefore, they can reasonably be combined; and, as long as there are inventors, there will always be room for improvement to any invention. In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In that Examiner has addressed all of the arguments regarding the original independent (parent) claims, Applicant's arguments for all the dependent claims are moot on the grounds that each limitation of the dependent claims are recited in their parent claim. Consequently, prosecution on the merits is closed. Examiner maintains the arguments set forth in the Office Action mailed on 13 October 2006 because Applicant has not amended the claims to overcome said arguments.